

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

**Ex parte GORDON J. FREEMAN, VASSILIKI A. BOUSSIOTIS
and LEE M. NADLER**

Appeal No. 2000-2063
Application No. 08/446,200

MAILED

APR 18 2003

ON BRIEF

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before WILLIAM F. SMITH, SCHEINER and MILLS,¹ Administrative Patent Judges.
SCHEINER, Administrative Patent Judge.

ON REQUEST FOR REHEARING²

This is a decision on appellants' request for rehearing of our earlier decision entered January 10, 2002, wherein we affirmed the examiner's final rejection of claims 1 through 4 under 35 U.S.C. § 103 as unpatentable over Hathcock, Linsley, Kuchroo and Janeway.

¹ Administrative Patent Judge Douglas W. Robinson retired subsequent to the Board's decision. Accordingly, Administrative Patent Judge William F. Smith has been substituted for Administrative Patent Judge Robinson. See In re Bose Corp., 772 F.2d 866, 869, 227 USPQ 1, 4 (Fed. Cir. 1985).

² The Request for Rehearing under 37 CFR § 1.197(b) was improperly titled "Petition for Rehearing."

Initially, we note that appellants are not asking us to reconsider our decision with respect to claim 1. Rather, the basis of the request is appellants' disagreement with the Board's finding that appellants had not complied with the second requirement of 37 CFR § 1.192(c)(7) (1977) (Claims stand or fall together "unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of this group are believed to be separately patentable" (emphasis added)). Specifically, appellants argue that "the Board improperly grouped claims 1-4, failing to properly review dependent claims 2-4" (Request for Rehearing under 37 CFR § 1.197(b), paper no. 24, page 3).

According to appellants, "specific substantive arguments as required under 37 CFR § 1.192(c)(8)" were set forth in the arguments section of the Brief, "in particular and for example, . . . page 8, third paragraph through page 9, first paragraph . . . which states in part that the present invention is based on the discovery that Th2 responses can be induced by stimulation of T cells with B7-2, as required by claim 2. Therefore, . . . Appellants did in fact 'separately address the patentability of the dependent claims' as required by the rules." Request, pages 2 and 3.

For the reasons set forth in our decision entered January 10, 2002 and the reasons set forth below, we find no error in our earlier consideration of claim 1 as representative of all the claims on appeal. We again note that the differences between independent claim 1 and dependent claims 2 through 4 were outlined in section VII of appellants' Brief (Grouping of Claims), but we find no statement anywhere in the Brief specific to claim 2, or any other claim, indicating why appellants regarded any of the

dependent claims to be separately patentable over the prior art.³ "Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable." 37 CFR § 1.192(c)(7) (1977).

Appellants' failure to present arguments in their brief regarding the separate patentability of the dependent claims over the prior art constituted a waiver of any argument that the Board must separately consider the patentability of claims 2 - 4. In any case, we note that the examiner expressly disagreed with appellants' statement in section VII of the Brief regarding the grouping of the claims,⁴ but appellants nevertheless allowed the application to be forwarded for a decision on appeal without challenging the examiner's position on this matter. Inasmuch as the grouping of claims is a matter within the jurisdiction of the examiner, relief should have been by way of petition under 37 CFR § 1.181, rather than by request for rehearing under 37 CFR § 1.197(b). Ex parte Schier, 21 USPQ2d 1016, 1019 (Bd. Pat. App. & Int. 1991).

We find no error in our consideration of claim 1 as representative of all the claims before us, therefore, we decline to grant the relief requested or change our earlier decision in any way.

³ Even the portion of the Brief specifically relied on by appellants largely concerns appellants' view that "the ordinarily skilled artisan would not have been motivated to contact a population of activated CD4+ T cells with an agent which modulates a B7-2 induced signal . . . to thereby modulate a Th2-type response" (Brief, page 9, emphasis altered from the original). As explained in the specification (pages 5 and 7), modulation encompasses both stimulation and inhibition of the signal and of the response.

⁴ On page 2 of the Answer, the examiner informed appellants that the "statement in the Brief that certain claims do not stand or fall together for the reasons set forth below in the Brief is not agreed with because such reasons are not readily apparent from appellant[s'] arguments."

FUTURE PROSECUTION

In the interest of completeness, we remind appellants and the examiner of the "Other Issues" raised in our earlier decision (pages 14 and 15). Furthermore, in the event of future prosecution, should appellants raise arguments directed to the separate patentability of claims limited to inducing a Th2-type response in activated T cells with B7-2, as opposed to claims limited to "modulating a Th2-type response . . . with an agent which modulates a B7-2-induced signal" (e.g., claim 1), we remind appellants that this issue was specifically addressed in our earlier decision. Therein, we explicitly concluded, based on an analysis of the examiner's rejection and the art relied upon, that "Kuchroo provides the suggestion and motivation, which appellants found missing in both Hathcock and Linsley, to use an agent, such as the B7-2 described by Hathcock, to modulate and control the differentiation of activated CD4+ T cells to become Th2 cells . . . beneficial in the treatment or abrogation of immune disease." Decision, page 11.

CONCLUSION

Having considered appellants' request to the extent discussed above, we decline to grant the relief requested or in any way change our decision.

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REHEARING DENIED

William F. Smith

William F. Smith
Administrative Patent Judge

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) BOARD OF PATENT

Toni R. Scheiner

Toni R. Scheiner
Administrative Patent Judge

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Demetra J. Mills

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